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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,681	03/09/2004	Karsten Hackbarth	H 5265	2641
423	7590	12/20/2005	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,681

Applicant(s)

HACKBARTH ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 8-27, 29 and 30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7, 28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. In view of the foreign priority document filed November 2, 2005, the issue is resolved.

### ***Claim Objections***

2. Claim 7 remains objected to because of the following informalities: On page 18, line 12, "aluminium" is believed to be a typo. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shustack (US Pat. 5,128,391) for the reasons adequately set forth from paragraph 4 of non-final office of April 28, 2005.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Shustack (US Pat. 5,128,387) for the reasons adequately set forth from paragraph 7 of non-final office of April 28, 2005.

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7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Razavi (US Pat. 5,629,365) for the reasons adequately set forth from paragraph 8 of non-final office of April 28, 2005.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Nagasawa et al. (US Pat. 4,205,018) for the reasons adequately set forth from paragraph 9 of non-final office of April 28, 2005.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) for the reasons adequately set forth from paragraph 10 of non-final office of April 28, 2005.

### ***Response to Arguments***

10. Applicant's arguments filed October 28, 2005 have been fully considered but they are not persuasive. Applicants argue that the prior art of Shustack et al. are silent on "at least one (meth)acrylate compound containing one or more acidic groups" and that Shustack et al. teach away from the claimed invention because Shustack et al. (col. 2, line 17-36) would cause undesirable effect, such as premature gelling. However, the examiner disagrees, because applicants' cited teaching is related to the background or the related art of the disclosed invention. Such background teaching does not constitute

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as negative teachings of the applicants' instantly claimed invention because Shustack et al. (col. 7, line 52-68) clearly indicate that when acid functional group containing compound is used, Novacure 3800 (an initiator) should be used to avoid the incompatibility issues dealing with the neutralization of the acid group containing compound with an amine group containing initiation system. Therefore, in view the reasons set forth above, the examples (preferable embodiment teachings) cited in Shustack et al. (col. 12, line 11-21) cannot be used to limit the broad teachings of Shustack et al., which clearly state that any multifunctional monomer is acceptable, insofar as they do not adversely affect the composition.

Regarding applicants' argument that Shustack et al. are silent on the viscosity as claimed because the oligomer concentration of Shustack et al. is too high. Since oligomers have higher viscosity to a monomer, applicants insist that it is not possible for the composition of Shustack et al. to possess the viscosity as claimed. However, applicants fail to recognize that the teachings in Shustack et al. also include low concentration ranges from 10% to 80% (US 5,128,387, col. 4, line 19-24).

Regarding applicants' argument that the combination of the prior art of Shustack et al. (US 5,128,391) with Razavi (US 5,629,365) is improper because the cans of Shustack et al. is for food-contact applications and it would be obvious for one of ordinary skill in art to incorporate a biocide into the coating of Shustack et al. However,

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applicants fail to recognize that the aluminum can application of Shustack et al. is not limited to food application alone.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Patent Examiner

December 12, 2005

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**